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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,934	08/27/2003	Stuart B. Smith	009608.0113	4108

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PATTON BOGGS LLP
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DENVER, CO 80202

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1796

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11/06/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/648,934	Applicant(s) SMITH, STUART B.	
	Examiner Margaret G. Moore	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-17 and 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The amendment filed 10/10/07 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the newly added definition of x, y and z. Applicants have attempted to insert a definition for x, y and z many times during the prosecution of this application. Each time the amendment is objected to as being new matter. Applicants are reminded that the original specification **did not define x, y or z at all**, so *any* newly added value (whether the upper limit be 20 as it is now or 100 as was added in the amendment dated 1/22/07) will be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

2. Claims 6 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The language in these claims is confusing in that it allows for more than 100 parts by weight of the total weight of polyol prepolymer chain extender. Since the silicone is present in an amount of from about 4 to about 38 parts by weight of 100 parts by weight of total polyol prepolymer chain extender, only from about 96 to about 62 parts by weight amine per 100 parts by weight of total polyol prepolymer chain extender can be present. This claim allows for much more than this. This is confusing.

3. As an aside, the Examiner notes that claim 8 has been cancelled. See page 3 of the amendments filed 10/10/07. This contrasts with that noted in the REMARKS section of applicants' response.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1, 2, 4, 5, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/10255, herein Herzig et al.

Applicants have not amended any of these claims and this rejection relies on the same rationale as noted in previous office actions. Applicants' response is not persuasive in establishing any unexpected results. The Examiner notes that each of applicants' arguments were made in previous responses and were not found to be persuasive at that time. To this extent, compare the first full paragraph on page 12 of the instant remarks with the paragraph starting on the bottom of page 12 of the remarks filed 1/22/07; compare the second full paragraph on page 12 of the instant remarks with the arguments starting on line 4 on page 13 of the remarks dated 1/22/07; compare the third full paragraph on page 12 of the instant remarks with the first full paragraph on page 13 of the remarks filed 1/22/07; compare the last paragraph on page 12 of the instant remarks with the last paragraph on page 13 of the remarks dated 1/22/07.

Applicants appear to be simply rehashing issues and arguments that were previously indicated as being unpersuasive. Note for instance the comments in the final office action dated 4/10/07. In lack of any new or persuasive arguments, this rejection is maintained.

While applicants' response stresses that Herzig does not teach stopping the reaction before it becomes a gel, note that the examples state that the product is free of gel formation.

6. Claims 1, 2, 4, 5, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raleigh et al.

This rejection relies on the rationale of record and as such this will not be repeated. Applicants' traversal is not persuasive. They note that Raleigh teaches reacting the silicone polymers with possibly polycarbonates, but this does not take away from the fact that patentees also specifically teach polyamines. It is also noted that Raleigh claims thermoplastics, but this too does not take away from the teachings on column 4 in Raleigh, upon which the Examiner relies for this rejection.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

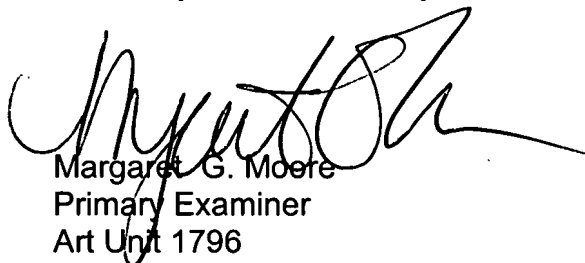
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4, 5, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Plueddemann.

Plueddemann teaches organosilicon hydroxyalkyl-amine polymers that are the reaction product of an epoxy silicone and an amine compound. Column 5, lines 60 and on, teaches that it is preferred to have remaining amine group in the hydroxyalkyl-amine compound to subsequently react with other epoxide groups. This corresponds to a molar excess of amine. Particular attention is drawn to Example 17 in which a branched siloxane having a phenyl group is reacted with a molar excess of guanidine. This anticipates the instant claims. Note that such a molar amount will correspond to a weight amount meeting claims 4 and 5.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.


Margaret G. Moore
Primary Examiner
Art Unit 1796

mgm
11/3/07